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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
08/926,872	09/10/1997	MICHAEL J. SULLIVAN	SLD2121	7653

24492 7590 01/13/2003

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EXAMINER

GORDON, RAEANN

ART UNIT	PAPER NUMBER
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3711

DATE MAILED: 01/13/2003

33

Please find below and/or attached an Office communication concerning this application or proceeding.

HCT

<b>Office Action Summary</b>	<b>Application No.</b> 08/926,872	<b>Applicant(s)</b> SULLIVAN ET AL.	
	<b>Examiner</b> Raeann Gorden	<b>Art Unit</b> 3711	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 04 November 2002.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1 and 3-8 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1 and 3-8 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☒ The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                             | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____  |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)         | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____                                    |

## **DETAILED ACTION**

### ***Specification***

The specification is objected to under 37 CFR 1.63(d)(iii) and 37CFR 1.78. The applicant has improperly stated that this application is a divisional of prior Application No. 08/631,613. Because this application adds and claims additional disclosure, it must be changed to a continuation-in-part application instead of a divisional. Applicant should note that with a continuation-in-part application the new subject matter presented in the instant case is not entitled to any date prior to the instant application's filing date of September 10, 1997.

### ***Oath/Declaration***

The declaration is objected to under 37 CFR 1.63 as being an improper divisional application. The declaration states that this application is a divisional of Application No. 08/631,613, however, this application adds substantial subject matter not presented in the prior application. The declaration must be changed to reflect the additionally recited subject matter and state that this application is a continuation-in-part of Application No 08/631,613.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact

terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1 and 3-8 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Claim 1 - the core with a specific gravity less than 1.4 is non-enabling. Applicant discloses a specific gravity of 1.47 and 1.17, one of which is over the 1.4 limitation. The remaining values in the range is non-enabling subject matter. The limitation requires the specific gravity to be less than 1.4 or from 0 to 1.4. The specific gravity of the intermediate layer is not enabling. The claim requires the intermediate layer to be less than 1.2. Applicant discloses values of 1.3, 0.95, 0.953, and 0.960 for the specific gravity being less than 1.2. Obviously 1.3 is outside the range in question. The values 0.953 and 0.960 cited on page 24 of the specification are specific gravity values for the base ionomer and not the actual composition of the intermediate layer. Therefore the only value relevant to the intermediate layer having a specific gravity less than 1.2 is the value 0.95. The JIS-C hardness from 85 to 89.9 of the intermediate layer is not enabling. Applicant discloses a Shore D hardness of at least 60, which converts to approximately 90 on the JIS-C scale.

Claim 6 - the difference of 0.1 to 0.5 between the core and the intermediate layer specific gravity is not enabling. Again values within the claimed range have been shown but the entire range is not enabling.

### ***Claim Rejections - 35 USC § 102***

The earliest filing date from which applicant can claim priority for the claimed subject matter is the filing date of the instant application therefore the following rejection applies:

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

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(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1 and 3-8 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Higuchi (EP 633043A).

### ***Response to Arguments***

Applicant's arguments filed November 4, 2002 have been fully considered but they are not persuasive. Applicant argues the 112, enablement rejection and recites MPEP 2164, p.2100-174. Applicant has been advised to add the subject matter to the specification however, the application type must be changed from a divisional to a continuation-in-part as shown above. Since applicant has not changed the type of the application the 112, first paragraph has been maintained. Applicant also argues the Examiner's view is ill-advised and the enablement requirement has been satisfied. The Examiner disagrees. Applicant's attention is directed to MPEP 2164.04, pgs. 2100-178 and 2100-179 stating: "(examiner must provide a reasonable explanation as to why the scope of protection provided by a claim is not adequately enabled by the disclosure)."

The sections also add:

The language should focus on those factors, reasons, and evidence that lead the examiner to conclude that the specification fails to teach how to make and use the claimed invention without undue experimentation, or that the scope of any enablement provided to one skilled in the art is not commensurate with the scope of protection sought by the claims. (emphasis added)

MPEP 2164.04 makes clear that the claims of the application should be rejected under 35 USC 112, 1<sup>st</sup> paragraph as containing subject matter which was not described in the specification to enable one of ordinary skill in the art to make and/or use the

invention as claimed. As shown above the Examiner has satisfied the rejection under 35 USC 112, 1<sup>st</sup> paragraph by specifically noting portions of the specification where the scope of enablement is not commensurate with that being sought by the instant claims.

Regarding applicant's question as to why certain dimensions are enabled by the instant specification while others are not, it should be abundantly clear to applicant that those dimensions recited in the claims and set forth by the specification are enabled while those that are recited in the claims but not set forth by the specification are not enabled.

Regarding the rejection under 35 USC 102(b), the rejection is maintained. The claimed subject matter does not obtain the benefit of the earlier filing dates. The application incorrectly claims priority to parent applications that it is not entitled.

### ***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

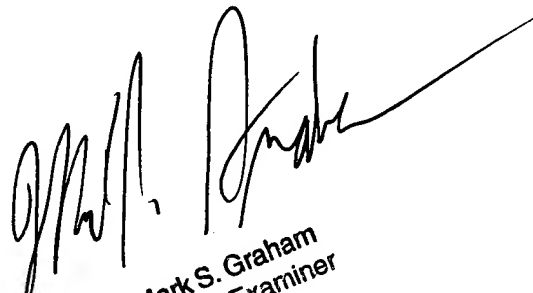
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Raeann Gorden whose telephone number is (703) 308-8354. The examiner can normally be reached Monday-Friday from 7:30 AM to 4:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Paul Sewell can be reached on 703-308-2126. The fax number for the organization where this application or proceeding is assigned is 703-308-7768.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1148.

Rg

January 8, 2003



Mark S. Graham  
Primary Examiner